

**REMARKS**

This amendment is in response to the Final Rejection of the pending claims in the Office Action of February 3, 2006.

Claims 1 through 24 are currently pending in the application.

Claims 1, 15, 19, 21, and 24 have been amended herein.

Support for the amendments may be found throughout the specification and particularly in paragraph [0046]. No new matter has been entered to the disclosure as the amendment clearly complies with 35 U.S.C. § 132. The amendments are to clearly distinguish over the cited art. The amendments are made without prejudice or disclaimer.

**35 U.S.C. § 103(a) Obviousness Rejections**

**Obviousness Rejection Based on Canon Kabushiki Kaisha (European Patent EP 1056247) in View of Ohta (U.S. Patent 6,980,319)**

Claims 1 through 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Canon Kabushiki Kaisha (European Patent EP 1056247) (hereinafter "CKK") in view of Ohta (U.S. Patent 6,980,319). Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant asserts that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

After carefully considering the cited art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited art.

Regarding presently amended independent claim 1, Applicant asserts that CCK and Ohta, even if combined, do not teach or suggest all of the claim limitations of presently amended independent claim 1 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that CCK and Ohta do not teach or suggest the claim limitation of the claimed invention calling for "specifying instructions in

a portion of the e-mail message for printing.” Applicant asserts that CCK teaches a “system which allows email users utilizing only cellular telephones or PDAs without a printing function to perform printing . . . .” Paragraph [0006]. Applicant asserts that CCK teaches providing four e-mail accounts for a user, where each e-mail account corresponds to a different printing function. *See Paragraphs [0040] and [0046]*. It was suggested by the Office that instructions are necessary for any network printing system; therefore, CCK must teach specifying instructions. *Final Office Action mailed February 3, 2006, p. 4*. However, Applicant asserts that CCK does not teach or suggest that the printing instructions are specified in a portion of an e-mail. Applicant asserts that CCK clearly teaches the opposite that the email does not contain any instructions. The e-mail addresses of CCK are evaluated by an application server to determine whether e-mail text, an attachment, the attachment and the text, or a URL should be printed. *See Paragraph [0027]*. Applicant asserts that evaluating an e-mail address by a server does not teach or suggest “specifying instructions in a portion of the e-mail message.” Applicant asserts that Ohta does not cure CCK’s failure to teach this presently amended claim limitation.

Applicant further asserts that CCK and Ohta do not teach or suggest the claim limitation of the claimed invention calling for “specifying instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes.” CCK teaches that the application server may shrink or expand the size of data to match a printer paper size or to switch between color and monochrome modes. *Paragraphs [106] and [107]*. However, that is not user selected. Applicant asserts that because the CCK user can only select, by choice of e-mail address, to have an attachment printed, it is impossible for CCK to teach user selected printing attributes. *See Paragraph [0040]*. Applicant asserts that the CCK user cannot select printing attributes. Applicant asserts that Ohta does not cure CCK’s failure to teach this presently amended claim limitation.

Therefore, for at least the above reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, presently amended independent claim 1 is allowable.

Claims 2 through 7 are allowable for at least the reason of depending from allowable claim 1.

Obviousness Rejection Based on CKK in View of Ohta and Further in View of Fabbio *et al.* (U.S. Patent 5,870,089)

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over CKK in view of Ohta and further in view of Fabbio *et al.* (U.S. Patent 5,870,089) (hereinafter “Fabbio”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding claim 8, Applicant asserts that CCK and Fabbio, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of presently amended independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103. Therefore, presently amended independent claim 1 is allowable. Claim 8 is allowable for at least the reason of depending from allowable presently amended independent claim 1.

Obviousness Rejection Based on CKK in View of Ohta

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over CKK in view of Ohta. Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 9 is allowable for at least the reason of depending from allowable presently amended independent claim 1.

Obviousness Rejection Based on CKK in View of Ohta and Further in View of Harkins *et al.* (U.S. Patent 5,689,642)

Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over CKK in view of Ohta and further in view of Harkins *et al.* (U.S. Patent 5,689,642) (hereinafter “Harkins”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding claims 10 and 11, Applicant asserts that CCK, Ohta, and Harkins, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of presently amended independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103. Therefore, presently amended independent claim 1 is allowable. Claims 10 and 11 are allowable for at least the reason of depending from allowable presently amended independent claim 1.

Additionally, regarding claim 10, Applicant asserts that Harkin does not teach or suggest the claim limitation of the claimed invention calling for “encoding [in] said printer

readable language [instructions for printing in a portion of the e-mail] prior to said sending the e-mail message.” Applicant asserts that Harkin teaches allowing an information sender to select a document’s disposition from fax, page printer, color printer, or e-mail. *Col. 11, lines 8-11*. Harkin does refer to converting formats, but there is no reference to encoding in printer readable languages, and it is clear from the remainder of the document that Harkin does not include printer readable languages as a possible format. *Col. 11, lines 28-41*. Non-limiting examples of printer readable languages are Hewlett-Packard’s HP-GL/2 and Adobe’s PostScript®. Applicant asserts that Harkin does not teach or suggest encoding printing instructions in a printer readable language. Therefore, for at least this reason, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, dependent claim 10 is allowable.

Claim 11 is further allowable for depending from allowable dependent claim 10.

Obviousness Rejection Based on CKK in View of Ohta

Claims 12 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over CKK in view of Ohta. Applicant respectfully traverses this rejection, as hereinafter set forth.

Claims 12 and 13 are allowable for at least the reason of depending from allowable presently amended independent claim 1.

Obviousness Rejection Based on CKK in View of Ohta and Further in View of Harkins

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over CKK in view of Ohta and further in view of Harkins. Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 14 is allowable for at least the reason of depending from allowable presently amended independent claim 1.

Obviousness Rejection Based on CKK in View of Ohta

Claims 15 through 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over CKK in view of Ohta. Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding presently amended independent claim 15, Applicant asserts that CCK and Ohta, even if combined, do not teach or suggest all of the claim limitations of presently amended independent claim 15 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that CCK and Ohta do not teach or suggest the claim limitation of the claimed invention calling for “specifying instructions in a portion of the e-mail message for printing.” Applicant asserts that CCK teaches a “system which allows email users utilizing only cellular telephones or PDAs without a printing function to perform printing . . . .” Paragraph [0006]. Applicant asserts that CCK teaches providing four e-mail accounts for a user, where each e-mail account corresponds to a different printing function. *See Paragraphs [0040] and [0046]*. It was suggested by the Office that instructions are necessary for any network printing system; therefore, CCK must teach specifying instructions. *Final Office Action mailed February 3, 2006, p. 4*. However, Applicant asserts that CCK does not teach or suggest that the printing instructions are specified in a portion of an e-mail. Applicant asserts that CCK clearly teaches the opposite that the email does not contain any instructions. The e-mail addresses of CCK are evaluated by an application server to determine whether e-mail text, an attachment, the attachment and the text, or an URL should be printed. *See Paragraph [0027]*. Applicant asserts that evaluating an e-mail address by a server does not teach or suggest “specifying instructions in a portion of the e-mail message.” Applicant asserts that Ohta does not cure CCK’s failure to teach this presently amended claim limitation.

Applicant further asserts that CCK and Ohta do not teach or suggest the claim limitation of the claimed invention calling for “specifying instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes.” CCK teaches that the application server may shrink or expand the size of data to match a printer paper size or to switch between color and monochrome modes. *Paragraphs [106] and [107]*. However, that is not user selected. Applicant asserts that because the CCK user can only select, by choice of e-mail address, to have an attachment printed, it is impossible for CCK to teach user selected printing attributes. *See Paragraph [0040]*. Applicant asserts that the CCK user cannot select printing attributes. Applicant asserts that Ohta does not cure CCK’s failure to teach this presently amended claim limitation.

Therefore, for at least the above reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and

does not teach or suggest all the claim limitations of the claimed invention. Accordingly, presently amended independent claim 15 is allowable.

Claims 16 through 18 are allowable for at least the reason of depending from allowable presently amended independent claim 15.

Regarding presently amended independent claim 19, Applicant asserts that CCK and Ohta, even if combined, do not teach or suggest all of the claim limitations of presently amended independent claim 19 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that CCK and Ohta do not teach or suggest the claim limitation of the claimed invention calling for “instructions specified in a portion of the e-mail message for printing.” Applicant asserts that CCK teaches a “system which allows email users utilizing only cellular telephones or PDAs without a printing function to perform printing . . . .” Paragraph [0006]. Applicant asserts that CCK teaches providing four e-mail accounts for a user, where each e-mail account corresponds to a different printing function. *See Paragraphs [0040] and [0046]*. It was suggested by the Office that instructions are necessary for any network printing system; therefore, CCK must teach specifying instructions. *Final Office Action mailed February 3, 2006, p. 4*. However, Applicant asserts that CCK does not teach or suggest that the printing instructions are specified in a portion of an e-mail. Applicant asserts that CCK clearly teaches the opposite that the email does not contain any instructions. The e-mail addresses of CCK are evaluated by an application server to determine whether e-mail text, an attachment, the attachment and the text, or an URL should be printed. *See Paragraph [0027]*. Applicant asserts that evaluating an e-mail address by a server does not teach or suggest “instructions specified in a portion of the e-mail message.” Applicant asserts that Ohta does not cure CCK’s failure to teach this presently amended claim limitation.

Applicant further asserts that CCK and Ohta do not teach or suggest the claim limitation of the claimed invention calling for “instructions specified in a portion of the e-mail message for printing the at least one document with user selected printing attributes.” CCK teaches that the application server may shrink or expand the size of data to match a printer paper size or to switch between color and monochrome modes. *Paragraphs [106] and [107]*. However, that is not user selected. Applicant asserts that because the CCK user can only select, by choice of e-mail address, to have an attachment printed, it is impossible for CCK to teach user selected printing attributes. *See Paragraph [0040]*. Applicant asserts

that the CCK user cannot select printing attributes. Applicant asserts that Ohta does not cure CCK's failure to teach this presently amended claim limitation.

Therefore, for at least the above reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, presently amended independent claim 19 is allowable.

Claims 20 is allowable for at least the reason of depending from allowable presently amended independent claim 19.

Regarding presently amended independent claim 21, Applicant asserts that CCK and Ohta, even if combined, do not teach or suggest all of the claim limitations of presently amended independent claim 21 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that CCK and Ohta do not teach or suggest the claim limitation of the claimed invention calling for "instructions in a portion of the e-mail message for printing." Applicant asserts that CCK teaches a "system which allows email users utilizing only cellular telephones or PDAs without a printing function to perform printing . . . ." Paragraph [0006]. Applicant asserts that CCK teaches providing four e-mail accounts for a user, where each e-mail account corresponds to a different printing function. *See Paragraphs [0040] and [0046]*. It was suggested by the Office that instructions are necessary for any network printing system; therefore, CCK must teach specifying instructions. *Final Office Action mailed February 3, 2006, p. 4*. However, Applicant asserts that CCK does not teach or suggest printing instructions in a portion of an e-mail. Applicant asserts that CCK clearly teaches the opposite that the email does not contain any instructions. The e-mail addresses of CCK are evaluated by an application server to determine whether e-mail text, an attachment, the attachment and the text, or an URL should be printed. *See Paragraph [0027]*. Applicant asserts that evaluating an e-mail address by a server does not teach or suggest "instructions in a portion of the e-mail message." Applicant asserts that Ohta does not cure CCK's failure to teach this presently amended claim limitation.

Applicant further asserts that CCK and Ohta do not teach or suggest the claim limitation of the claimed invention calling for "instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes." CCK teaches that the application server may shrink or expand the size of data to match a printer paper size

or to switch between color and monochrome modes. *Paragraphs [106] and [107]*.

However, that is not user selected. Applicant asserts that because the CCK user can only select, by choice of e-mail address, to have an attachment printed, it is impossible for CCK to teach user selected printing attributes. *See Paragraph [0040]*. Applicant asserts that the CCK user cannot select printing attributes. Applicant asserts that Ohta does not cure CCK's failure to teach this presently amended claim limitation.

Therefore, for at least the above reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, presently amended independent claim 21 is allowable.

Claims 22 is allowable for at least the reason of depending from allowable presently amended independent claim 21.

#### Obviousness Rejection Based on CKK in View of Ohta and Further in View of Harkins

Claim 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over CKK in view of Ohta and further in view of Harkins. Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 23 is allowable for at least the reason of depending from allowable presently amended independent claim 19.

#### Obviousness Rejection Based on CKK in View of Ohta

Claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over CKK in view of Ohta. Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding presently amended independent claim 24, Applicant asserts that CCK and Ohta, even if combined, do not teach or suggest all of the claim limitations of presently amended independent claim 24 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that CCK and Ohta do not teach or suggest the claim limitation of the claimed invention calling for "instructions in a portion of the e-mail message for printing." Applicant asserts that CCK teaches a "system which allows email users utilizing only cellular telephones or PDAs without a printing function to perform printing . . . ." Paragraph [0006]. Applicant asserts that CCK teaches providing four e-mail accounts for a user, where each e-mail account corresponds to a different printing



function. *See Paragraphs [0040] and [0046]*. It was suggested by the Office that instructions are necessary for any network printing system; therefore, CCK must teach specifying instructions. *Final Office Action mailed February 3, 2006, p. 4*. However, Applicant asserts that CCK does not teach or suggest printing instructions in a portion of an e-mail. Applicant asserts that CCK clearly teaches the opposite that the email does not contain any instructions. The e-mail addresses of CCK are evaluated by an application server to determine whether e-mail text, an attachment, the attachment and the text, or an URL should be printed. *See Paragraph [0027]*. Applicant asserts that evaluating an e-mail address by a server does not teach or suggest "instructions in a portion of the e-mail message." Applicant asserts that Ohta does not cure CCK's failure to teach this presently amended claim limitation.

Applicant further asserts that CCK and Ohta do not teach or suggest the claim limitation of the claimed invention calling for "instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes." CCK teaches that the application server may shrink or expand the size of data to match a printer paper size or to switch between color and monochrome modes. *Paragraphs [106] and [107]*. However, that is not user selected. Applicant asserts that because the CCK user can only select, by choice of e-mail address, to have an attachment printed, it is impossible for CCK to teach user selected printing attributes. *See Paragraph [0040]*. Applicant asserts that the CCK user cannot select printing attributes. Applicant asserts that Ohta does not cure CCK's failure to teach this presently amended claim limitation.

Therefore, for at least the above reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, presently amended independent claim 24 is allowable.

Applicant submits that claims 1 through 24 are clearly allowable over the cited art.

Applicants request entry of this amendment for the following reasons:

The amendment is timely filed.

The amendment does not require any further search or consideration.

The amendment places the application in condition for allowance.

Respectfully submitted,



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